## In the United States Patent and Trademark Office

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| In re the application of: Shamrakov | | |
| Filed: 06/26/2001 | Group Art Unit: | 3692 |
| For: Integration of Computer Applications and E-Business Capability | Examiner: | Clement B. Graham |
| App. No.: 09/892,147 | | |
| Appellant's Docket: JP920000426US1 | | |

Mail Stop Appeal Brief - Patents
Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from the Final Rejection of January 10, 2008, in which all pending claims 4-7, 9, 14-17, 19 and 21-22 were rejected.

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## PARTY IN INTEREST

The assignee, International Business Machines Corporation, is the real party in interest.

## RELATED APPEALS AND INTERFERENCES

This is the first appeal in the present patent application. There are no related appeals or interferences known to the appellant or its legal representative.

## STATUS OF CLAIMS

**Claims pending:**

Independent claims 21-22 and dependent claims 4-7, 9, 14-17 and 19 stood pending in the application at the time of the Office action herein appealed, (the Final Office Action) of January 10, 2008.

**Claims canceled herein:**

Appellant herein requests cancellation of claim 22 and its dependent claims 14-17 and 19, without prejudice, i.e., merely to expedite this appeal and subsequent allowance.

**Claims previously canceled:**

Claims 1-3, 8, 10-13, 18 and 20 were previously canceled.

**Claims rejected:**

All the pending claims stand rejected in the Final Office Action.

**Claims appealed:**

Claim 21 is appealed and argued herein.

**History:**

The present application, filed June 26, 2001, presented original claims 1-20.

In a first Office action of March 15, 2006, Examiner rejected claims 1-20 under 35 USC 102(e) as being anticipated by Esposito et al. (6,587,838). In Reply A of June 15, 2006, Appellant canceled the independent claims, i.e., claims 1 and 11, and added new independent claims 21 and 22 to overcome the rejection. Appellant also canceled claims 2-3, 8, 10, 12-13,

18 and 20 and amended dependent claims 4-7, 9, 14-17 and 19 to conform them to new independent claims 21 and 22.

In a second, non-final Office action of September 26, 2006, Examiner rejected claims 4-7, 9, 14-17, 19, 21, and 22, under 35 USC 102(e) as being anticipated by Esposito. Appellant amended claims 21 and 22 to make it more clear that the present invention is not anticipated by an arrangement, as claimed, in which there is offering of a hosting service providing *merely one* of the claimed hosting service steps. Without information about pertinence of the specific parts, Appellant's effort to fully respond and distinguish the invention over the prior-art rejections was impeded.

In a third, non-final Office action of July 26, 2007, Examiner rejected claims 12, 21-22 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Examiner also rejected claims 4-7, 9, 14-17, 21 and 22 as being unpatentable over Arganbright et al in view of Muyres et al. Since claim 12 was previously canceled and claim 21 recites neither "to store" nor "operable to" nor any variants thereof, Appellant assumed the rejection applied to claims 16 and 22, and not claim 21 or canceled claim 12. Appellant therefore submitted amendments to claims 16 and 22. Without information about pertinence of the specific parts, Appellant's effort to fully respond and distinguish the invention over the prior-art rejections was once again impeded.

The Final Office Action rejects claims 4-7, 9, 14-17, 19, 21 and 22 as being unpatentable over Kennedy et al in view of Kumar et al. and rejects claims 21 and 22 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Without information about pertinence of the specific parts, Appellant's effort to fully respond and distinguish the invention over the prior-art rejections was once again impeded.

Appellant appealed the rejection in a Notice of Appeal filed April 6, 2008.

## SUMMARY OF AMENDMENTS

The following amendments are submitted in connection with this appeal:

Appellant requests cancellation of claims 14-17, 19 and 22.

Appellant also herein submits an amendment to claim 21 to insert a comma in a line that is two lines before the ending line, as set out in Appendix AA herein below.

## SUMMARY OF CLAIMED SUBJECT MATTER

**Identification of steps**

Claim 21 describes a method for offering hosting services. As required for Appeal Briefs, the following specifically identifies matter in the claim that Appellant acknowledges is recited as *steps*. (Further below, the claims are herein related to one or more particular embodiments described in the specification and drawings.)

The claim begins with a first step, as follows: "a) hosting a plurality of applications on a host computer system at a data center, wherein hosting the applications includes: executing an first shopping application for a first shopping process on the data center host computer system, the first shopping process being accessible to shoppers by Internet communications wherein the first shopping process performs" a sub step.

The claim ends with a last step, as follows: "b) performing a hosting service by the host computer system responsive to one of the customers selecting from among the first, second, third, fourth, fifth and sixth hosting service steps, and wherein sales are transacted with shoppers for the customers responsive to ones of the selected hosting service steps being performed on the host computer system." (Note the claim language set out immediately above for the last step includes a comma after "second" that is inserted according to an amendment submitted herein to correct a typographical error.)

The claim recites a number of substeps that are included in the first step, as follows:

- "a first hosting service step"
- "communicating with a first integration process and a first resource planning process via Internet communications to transact first sales, wherein the first resource planning process is a process of a first resource planning application on a host computer system located remotely from the data center and the first integration process is a process of a first integration application on a host computer system located remotely from the data center" (included in the first hosting service step)
- "executing an application for a second resource planning process on the data center host computer system"
- "a second hosting service step" (included in the step of executing an application for a second resource planning process on the data center host computer system)
- "communicating with a production process via Internet or dedicated link communications, wherein the production process is a process of a production application on a host computer located remotely from the data center" (included in the second hosting service step)
- "executing an application for a second integration process on the data center host computer system" (included in the second hosting service step)
- "a third hosting service step" (included in the step of executing an application for a second integration process)
- "coupling communications between the first shopping process and the second resource planning process to transact second sales" (included in the third hosting service step)
- "a fourth hosting service step"
- "coupling communications between the second resource planning process and a second shopping process, wherein the second shopping process is a process of a second shopping application accessible to shoppers by Internet communications on a host computer located remotely from the data center, the communications between the second resource planning process and the second shopping process being Internet communications to transact third sales" (included in the fourth hosting service step)
- "a fifth hosting service step"

- "coupling communications between the first shopping process and a third resource planning process to transact fourth sales, wherein the third resource planning process is a process of a third resource planning application on a host computer located remotely from the data center" (included in the fifth hosting service step)
- "a sixth hosting service step"
- "coupling communications between a certain process and a third shopping process, wherein the third shopping process is a process of a third shopping application accessible to shoppers by Internet communications on a host computer located remotely from the data center and the certain process is a process of a certain application on a host computer located remotely from the data center" (included in the sixth hosting service step)

**Claims related to particular embodiments of the specification and drawings**

The specification of the present application provides an exemplary embodiment of the invention and describes the method of claim 21 in terms of that embodiment. Specifically, regarding support for claim 21, see the following illustrations and the remarks following.

Figure 3 shows an integration server 350, which correspondingly runs an integration process. See, e.g., specification, page 9, line 9, and page 10, lines 30-31 ("MQ Series Server . . . integrates the marketplace and the ERP components").

Figure 3 also shows an e-business server 340, which correspondingly runs a shopping process. See, e.g., specification, page 9, line 8, and page 4, lines 18-19 (shopping process running in a WebSphere™ Commerce Suite of applications).

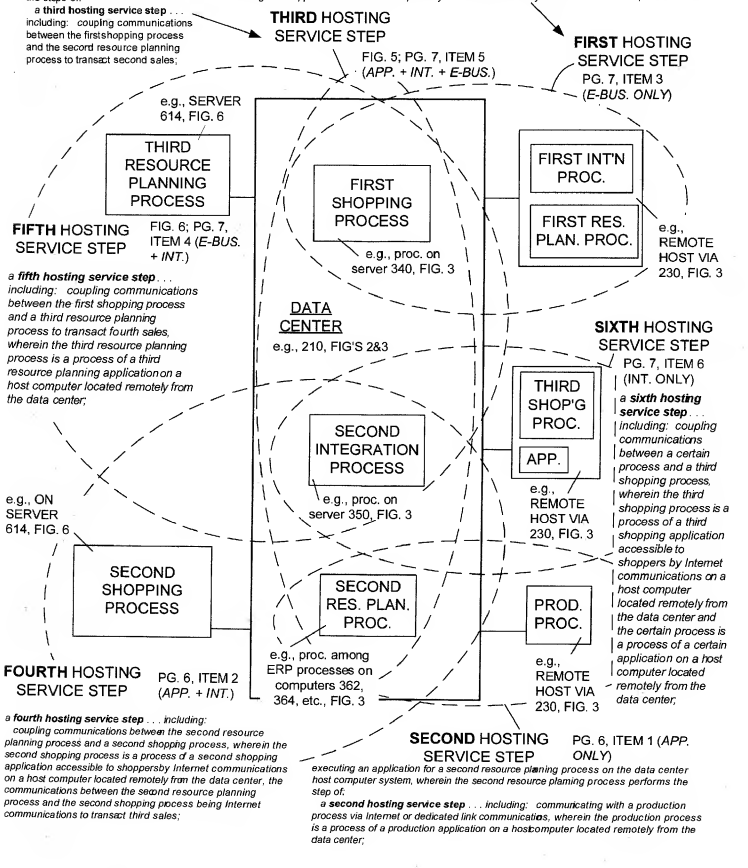
Figure 3 also shows enterprise resource planning computers 362, 364, 370 and 380, which correspondingly run resource planning processes. See also, specification, page 9, lines 11-13, and page 4, lines 17-18 (resource planning process running in a SAP™ Enterprise Resource Planning (ERP) application), and page 13, lines 12-16 (SAP system has development (DEV), test (TST), and production (PRD) components).

Immediately below is a figure that relates claim 21 to the specification and drawings. Following that is further description relating claim 21 to the specification and drawings.

executing an application for a second integration process on the data center host computer system, wherein the second integration process performs the steps of:

a **third hosting service step** . . . including: coupling communications between the first shopping process and the second resource planning process to transact second sales;

*executing an first shopping application for a first shopping process on the data center host computer system, the first shopping process being accessible to shoppers by Internet communications wherein the first shopping process performs the step of:* ***a first hosting service step*** *. . . including: communicating with a first integration process and a first resource planning process via Internet communications to transact first sales, wherein the first resource planning process is a process of a first resource planning application on a host computer system located remotely from the data center and the first integration process is a process of a first integration application on a host computer system located remotely from the data center;*



The method for offering hosting services includes hosting a plurality of applications (e.g., resource planning applications, such as SAP ERP application, page 4, lines 16-18, executing on servers 362 and 364, Fig. 3, and page 13, lines 15-16, in application layer 106, Fig. 1, and page 5, lines 21-28; e.g., e-business application, such as Websphere Commerce Suite, page 4, lines 18-19, executing on server 340, Fig. 3, and page 9, lines 1-9, in e-business layer 102, Fig. 1). The applications are hosted on a host computer system (e.g., infrastructure 100, Fig's 1 and 9) at a data center (e.g., 210, Fig's 2 and 3).

First hosting service step:

Hosting the applications includes executing a first shopping application (e.g., e-business application for selling goods and services via the Internet, page 5, lines 23-28) for a first shopping process (e.g., process of e-business application) on the data center host computer system (e.g., e-business server 340, Fig. 3). The first shopping process is accessible to shoppers (e.g., customer 170, Fig. 1) by Internet communications (e.g., 220 or 230, Fig. 3; page 6, lines 7-8, page 8, lines 21-22).

The first shopping process performs the step of a first hosting service step (e.g., page 7, item 3, "e-business only" selection, and Fig. 4 ). This includes communicating with a first integration process (e.g., customer 170, Fig. 1, has own integration applications, such as 820 and 830, Fig. 8, page 14, line 15 and Fig. 9 MQ client 950) and a first resource planning process via Internet communications (e.g., customer 170, Fig. 1, has own e-business application, such as Fig. 9, e-business suite 161 and accesses data center 210 hosting service via Internet link 230, Fig. 3, and e-business layer 102, Fig's 1 and 9) to transact first sales ("e-business only" involves venders selling goods and services to their customers, page 7, lines 1-3).

The first resource planning process is a process of a first resource planning application on a host computer system located remotely from the data center and the first integration process is a process of a first integration application on a host computer system located remotely from the data center (customer 170 Fig. 1 has own integration application, e.g., 820 and 830, Fig. 8, page 14, line 15 and MQ client 950, Fig. 9; customer 170 Fig. 1 has own e-business application, e.g., e-business suite 161 Fig. 9 and accesses data center 210 hosting service via e-business layer 102, Fig's 1 and 9).

Second hosting service step:

Hosting the applications further includes executing an application for a second resource planning process (e.g., processes on server/s 438 Fig. 4, e.g., processes on servers 362 and 364 Fig. 3, page 13, lines 15-16) on the data center host computer system (100 Fig's 1 and 9, 210 Fig's 2 and 3, 430 Fig. 4).

The second resource planning process performs the step of a second hosting service step (page 6, item 1, "application only"), which includes communicating with a production process via Internet (e.g., 220 or 230 Fig's 2 and 3) or dedicated link communications (e.g., 240 or 250 Fig's 2 and 3; page 8, line 28 - page 9, line 14). The production process is a process of a production application on a host computer located remotely from the data center (e.g., on a computer at a remote location such as customer 610, Fig. 6, vendor's house bank 130, Fig. 10, etc.).

Third hosting service step:

Hosting the applications further includes executing an application for a second integration process on the data center host computer system (100 Fig's 1 and 9, 210 Fig's 2 and 3, 530 Fig. 5), wherein the second integration process performs the steps of a third hosting service step (page 7, item 5, "application, integration and e-business"). The third hosting service step includes coupling communications between the first shopping process (e.g., process of e-business application, such as Websphere Commerce Suite, page 4, lines 18-19, executing on server 340, Fig. 3 and page 9, lines 1-9, in e-business layer 102, Fig. 1; also, e.g., process of e-business server 534 Fig. 5) and the second resource planning process (e.g., processes on servers 362 and 364 Fig. 3, page 13, lines 15-16; also, e.g., process of ERP application server/s 538 Fig. 5) to transact second sales ("e-business capability," page 7, line 20; vendors and their customers, page 7, line 23).

Fourth hosting service step:

Hosting the applications further includes a fourth hosting service step (page 6, item 2, "application and integration"), which includes coupling communications between the second resource planning process (e.g., processes on servers 362 and 364 Fig. 3, page 13, lines 15-16; also, e.g., process of ERP application server/s 538 Fig. 5) and a second shopping process (e.g., instance of process on server 614, Fig. 6, or server 710, Fig., 7, etc.). The second shopping

process is a process of a second shopping application accessible to shoppers (e.g., customer 170, Fig. 1) by Internet communications (e.g., 220 or 230 Fig's 2 and 3) on a host computer e.g., server 614, Fig. 6, or server 710, Fig., 7, etc.) located remotely from the data center (e.g., 210, Fig. 3). The communications between the second resource planning process and the second shopping process are Internet communications to transact third sales (integration of hosted ERP application with vendor's own e-business application, page 6, lines 31-32).

Fifth hosting service step:

Hosting the applications further includes a fifth hosting service step (e.g., page 7, item 4, "e-business with integration"), which includes coupling communications between the first shopping process (e.g., process of e-business server 340, Fig. 3) and a third resource planning process (e.g., instance of process on an ERP system of a vendor, page 7, line 16) to transact fourth sales (e-business capability, page 7, line 15). The third resource planning process is a process of a third resource planning application on a host computer (e.g., a server such as 614, Fig. 6, or server 710, Fig., 7, etc., but serving an ERP application) located remotely from the data center (e.g., 210, Fig. 3).

Sixth hosting service step:

Hosting the applications further includes a sixth hosting service step (page 7, item 6, "integration only" selection ), which includes coupling communications between a certain process (e.g., a server such as 614, Fig. 6, or server 710, Fig., 7, etc., but serving an ERP application, for example) and a third shopping process (e.g., instance of process on server 614, Fig. 6, or server 710, Fig., 7, etc.). The third shopping process is a process of a third shopping application accessible to shoppers (e.g., customer 170, Fig. 1) by Internet communications (e.g., 220 or 230 Fig's 2 and 3) on a host computer (e.g., server 614, Fig. 6, or server 710, Fig., 7, etc.) located remotely from the data center (e.g., 210, Fig. 3).

The certain process is a process of a certain application on a host computer (e.g., a server such as 614, Fig. 6, or server 710, Fig., 7, etc., but serving an ERP application, for example) located remotely from the data center (e.g., 210, Fig. 3).

Finally, the method for offering hosting services includes performing a hosting service by the host computer system responsive to one of the customers selecting from among the first, second, third, fourth, fifth and sixth hosting service steps, wherein sales are transacted

with shoppers for the customers responsive to ones of the selected hosting service steps being performed on the host computer system (page 2, line 22 - 30).

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. With regard to claims 4-7, 9, 14-17, 19, 21 and 22, which stand rejected under 35 USC 103(a) as being anticipated by US Patent 6,963,847 ("Kennedy") in view of US Patent Application Publication US2002/0042755 ("Kumar"), Applicant herein requests review of this rejection only as to claim 21.

2. With regard to claims 21 and 22, which stand rejected under 35 USC 112 on grounds that "customers selecting from among the first, second, third, fourth, fifth and sixth hosting service" is indistinct because it is indeterminate whether the first, second, third, fourth, fifth and sixth hosting services are the same or different hosting services., Applicant herein requests review of this rejection only as to claim 21.

# ARGUMENTS

## 1. Rejection Under 35 USC103(a) over Kennedy in view of Kumar.

### Claim 21

Claim 21 stands rejected under 35 USC 103(a) as being anticipated by US Patent 6,963,847 ("Kennedy"), in view of US Patent Application Publication US2002/0042755 ("Kumar"). Appellant respectfully submits that the rejection is improper.

### Examiner's Position

The Final Office Action asserts that Kennedy meets all the limitations of claim 21 except certain aspects of part b) in the claim, repeatedly citing Kennedy's abstract, column 3, lines 65-67, and all of columns 4-9. Final Office Action, pages 3-5 .

The Final Office Action cites Kumar, Fig. 3 and paragraphs 23, 52, and 53, and asserts that this portion of Kumar teaches the following:

- Available-to-promise (ATP) servers each support or are associated with a planning engine able to provide, among other things, product availability responses to component ATP requests in the form of component quotations.
- One or more planning engines associated with ATP servers may also provide pricing and other additional capabilities, as appropriate.
- A local fulfillment manager (LFM) that is located at or otherwise associated with an ATP server manages the interaction between ATP server and some unspecified other device or process.
- In one embodiment, LFM 22 is a "thin" engine whose primary responsibility within system is to communicate component requests, component quotations, component quotation confirmations, and component promises to and from ATP server in a suitable format, and to monitor their status to the point of order fulfillment.

Based on these asserted teachings, the Final Office Action concludes it would have been obvious that customers may select from among the claimed hosting service steps, which the Final Office Action earlier asserts are taught by Kennedy. Final Office Action, pages 5-6 .

**Appellant's Rebuttal**

Issue 1. As in the two immediately preceding Office actions, the Final Office Action does not explain the *pertinence* of the specific parts of the primary reference relied upon for the rejection. The rejection is, therefore, improper. MPEP 706, citing 37 CFR 1.104(c)(2) Nature of examination (". . . When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.").

Appellant submits that the Kennedy reference relied upon for the rejection is complex and describes inventions other than that claimed by Appellant, but the Office Action does not explain the specific parts of the reference relied upon for rejection of each specific element or step and the pertinence of the specific parts.

As before, the Final Office Action relies upon a single, long set of passages for numerous claim segments with no explanation as to the pertinence of the passages. Appellant submits that the mere length of the portion cited indicates on its face that Kennedy is complex and its pertinence not apparent. In particular, the Final Office Action divides each of the independent claim 21 into seven segments, in a fashion like the two prior Office actions. Final Office Action, pages 3-5 (claim 21). To meet the first six segments for each of claims 21 and 22, the Office action repeatedly cites the same set of passages in Kennedy, which have a total of more than 3600 words. The repeated cites never explain pertinence. Thus, for example, regarding one 52 word segment of claim 21 (regarding second integration process and third hosting step), the Final Office Action points to this 3600+ word portion of Kennedy with no explanation of pertinence. Final Office Action, page 4.

Further, the same 3600+ part of Kennedy is also pointed out in the Final Office Action for the rejection of each and every one of the 10 dependent claims. Overall, this same set of 3600+ words is identically cited over 20 times in the Office action. Further, no other parts of Kennedy are cited. The Office action offers no specific explanation about the significance of

individual portions of the 3600+ word portion of Kennedy in any of the 20+ citations. Appellant submits that on its face this further indicates that the pertinence of Kennedy is not apparent and the examination is not complete with respect to the patentability of the invention as claimed.

Further, Kennedy describes inventions other than that claimed by Appellant. For example, the present application makes no mention of "order quantity constraints" that do not allow a fulfillment server to reduce a quotation quantity without affecting validity of quotation, nor does the present application mention "cancellation restrictions," as described by Kennedy, col. 7, lines 30-45.

Based on the above, Appellant submits that the examination is not complete with respect to the patentability of the invention as claimed and that the rejection of claim 21 in the Final Office Action is improper under 37 CFR 1.104 (c)(2) and MPEP 707. Appellant respectfully requests that if the claim is not now allowed, then prosecution should be re-opened, wherein a new Office action is issued properly setting out the specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*. [1]

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[1] Note also that Appellant received no response to a written request for telephonc interview about this matter in Appellant's reply of October 26, 2007, nor to subsequent telephone voice messages left for the Examiner requesting either i) assurance that the amended claims would be allowed, ii) guidance as to Examiner's position regarding a number of specific questions, or iii) assurance a new Office Action would be issued properly setting out specific parts of the references relied upon for the rejection and an explanation of the *pertinence of the specific parts*, in a manner responsive to each of the numerous specific questions. Instead, the Final Office Action was issued, in which two new references were substituted for two prior references, but with the same lack of explanation as described herein above. Some of the specific questions for which Appellant requested guidance in the interview request are set out for illustration as follows:

> Regarding the first hosting service step ...What specific process taught by [the cited references] does the rejection rely upon for the claimed first shopping process that is on a data center host computer system, that is accessible to shoppers by Internet communications and that communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales, where the first shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected first hosting service step being performed on the host computer system?
>
> Note that claim also states that the claimed first integration process is on a *host computer system located remotely* from the data center. What specific process taught by [the cited references] does the rejection rely upon for the claimed *first integration process*? What specific host computer system taught by [the cited references] does the rejection rely upon for this *remotely located host* computer system?
>
> Note that the claim also states that the claimed first resource planning process is on a *host computer system located remotely* from the data center. What specific process taught by [the cited references] does the rejection rely upon for the claimed *first resource planning process*? What specific host computer system taught by [the cited references] does the rejection

Issue 2.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (citing In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Neither Kennedy nor Kumar, nor their combination, teach or suggest all the limitations of claims 21 or 22.

Kennedy teaches that a client submits requests pertaining to a specific product purchase at a fulfillment server. See, e.g., Kennedy, col. 5, lines 13-26. The fulfillment server in turn brokers component requests corresponding to these line-items to "available to purchase" servers using a "local fulfillment manager" interface and a network. Id. The LFM uses the ATP servers to perform computations and record reservations and provides resulting quotations to the fulfillment server, which presents a unified overall quotation to the requesting client. Id. The fulfillment server may "maintain information regarding suppliers ...which fulfillment server 16 may use for order promising . . ." This includes maintaining definitions for suppliers at fulfillment server 16." Kennedy, col. 7, lines 30-45.

However, neither Kennedy nor Kumar, nor their combination, teach or suggest the following:

> ... a first shopping process on the data center host computer system ...perform[ing] ...a first hosting service ...communicating with a first integration process and a first resource planning process via Internet communications to transact first sales, wherein the first resource planning process is ...located remotely from the data center and the first integration process is ...located remotely from the data center;
>
> ... a second resource planning process on the data center host computer system ...perform[ing] ...a second hosting service ...communicating with a production process via Internet or dedicated link communications, wherein the production process is ...located remotely from the data center;

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rely upon for this *remotely located host*?

Regarding the second hosting service step ... What specific process taught by [the cited references] does the rejection rely upon for the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications? What specific process taught by [the cited references] does the rejection rely upon for the claimed *production process*? Note that the claim also states that the production process is on a host computer located remotely from the data center. What specific host computer system taught by [the cited references] does the rejection rely upon for this *remotely located host*?

* * *

> ...a second integration process on the data center host computer system ...perform[ing] . . . a third hosting service ...coupling communications between the first shopping process and the second resource planning process [i.e., on the data center host] to transact second sales;
>
> a fourth hosting service ...coupling communications between the second resource planning process and a second shopping process ...of a second shopping application accessible to shoppers by Internet communications ...located remotely from the data center ...to transact third sales;
>
> a fifth hosting service ...coupling communications between the first shopping process and a third resource planning process to transact fourth sales, wherein the third resource planning process is ...located remotely from the data center;
>
> a sixth hosting service ...coupling communications between a certain process and a third shopping process, wherein the third shopping process is ...accessible to shoppers ...on a host computer located remotely from the data center and the certain process is a process ...located remotely from the data center; and
>
> ...performing a hosting service by the host computer system responsive to one of the customers selecting from among the first, second third, fourth, fifth and sixth hosting service ...and wherein sales are transacted with shoppers for the customers responsive to ones of the selected hosting service steps being performed on the host computer system

as recited in claim 21.

More particularly, regarding the first hosting service step, the claim specifically states that a first shopping process on a data center host computer system and that is accessible to shoppers by Internet communications, communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales. The claim also states that the first resource planning process is on a computer system *host located remotely from the data center*. The claim also states the first integration process is on a host computer system located remotely from the data center. Neither Kennedy nor Kumar nor their combination teach a specific process meeting the claimed first shopping process that is on a data center host computer system and that is accessible to shoppers by Internet communications and that communicates with a *first integration process* and a *first resource planning process* via Internet communications to transact first sales.

Neither Kennedy nor Kumar nor their combination teach a specific process meeting the claimed first integration process on a *host computer system located remotely* from the data center. That is, neither Kennedy nor Kumar nor their combination teach a specific process

meeting the claimed *first integration process*. All the more certainly, neither Kennedy nor Kumar nor their combination teach a first integration process that is specifically *remotely located on a host* computer system.

Note that the claim also states that the claimed first resource planning process is on a *host computer system located remotely* from the data center. Neither Kennedy nor Kumar nor their combination teach a specific process meeting the claimed *first resource planning process*. All the more certainly, neither Kennedy nor Kumar nor their combination teach this first resource planning process that is specifically *remotely located on a host* computer system.

Regarding the second hosting service step, the claim specifically states that a *second resource planning process* on the data center host computer system communicates with a *production process* via Internet or dedicated link communications. Neither Kennedy nor Kumar nor their combination teach a specific process meeting the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications, where the selectable shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected second hosting service step being performed on the host computer system.

The rejection does not identify a specific process taught by Kennedy or Kumar relied upon for the claimed *second resource planning process* that is on the data center host computer system and that communicates with a production process via Internet or dedicated link communications. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not identify a specific process taught by either reference for the claimed *production process*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Regarding the third hosting service step, the claim specifically states that a *second integration process* on the data center host computer system couples communications between the first shopping process and the second resource planning process to *transact second sales*, where the third shopping process is selectable by a customer and where sales are transacted

with shoppers for the customer responsive to the selected third hosting service step being performed on the host computer system. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not identify a specific process taught by the references for the claimed *second integration process* that is on the data center host computer system and that couples communications between the first shopping process and the second resource planning process to transact second sales. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Regarding the fourth hosting service step, the claim specifically states that Internet communications to *transact third sales* are coupled between the second resource planning process and a *second shopping process* that is accessible to shoppers by Internet communications, where the fourth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected fourth hosting service step being performed on the host computer system. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not identify a specific process taught by the references for the claimed *second shopping process* that is accessible to shoppers by Internet communications and that communicates with the second resource planning process for transacting third sales. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Note that the claim also states that the second shopping process is on a *host computer located remotely* from the data center. The rejection does not state what specific host computer system is taught by the references that the rejection relies upon for this *remotely located host* for such a second shopping process. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Regarding, the fifth hosting service step, the claim specifically states that communications are coupled between the first shopping process and a *third resource planning process* to transact fourth sales, where the fifth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected fifth hosting service step being performed on the host computer system. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not state what specific process is taught by the references that the rejection relies upon for the claimed *third resource planning process*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Note that the claim also states that the third resource planning process is on a *host computer located remotely* from the data center. The rejection does not state what specific host computer system is taught by the references that the rejection relies upon for this *remotely located host*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

Regarding the sixth hosting service step, the claim specifically states that communications are coupled between a certain process and a *third shopping process,* that the third shopping process is accessible to shoppers by Internet communications, and that the third shopping process is on a host computer *located remotely* from the data center, where the sixth shopping process is selectable by a customer and where sales are transacted with shoppers for the customer responsive to the selected sixth hosting service step being performed on the host computer system. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not state what specific process is taught by the references that the rejection relies upon for the claimed *certain process* that is coupled to the third shopping process. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this. Note that the claim also states that the certain process is on a host computer *located remotely* from the data center. The rejection does not state what specific host computer system taught by the references that the rejection relies upon for this *remotely located host*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

The rejection does not state what specific process is taught by the references that the rejection relies upon for the claimed *third shopping process*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this. Note that the claim also states that the third shopping process is on a host computer *located remotely* from the data center. The rejection does not state what specific host computer system is taught by the references that the rejection relies upon for this *remotely located host*. Applicant submits that neither Kennedy, nor Kumar, nor their combination teach this.

For at least these reasons, Appellant submits that claim 21 is patentably distinct. (Accordingly, claims 4-7 and 9 are also allowable at least because they depend on allowable claim 21.)

**2. Rejection Under 35 USC 112**

**Claim 21**

Independent claim 21 stands rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Appellant respectfully submits that the rejection is improper.

**Examiner's Position**

Claim 21 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. In particular, Examiner asserts he is "unable to ascertain if the first, second, third, fourth, fifth and sixth hosting service [steps] are the same or different hosting services" and that the specification fails to clarify the meaning of "the limitation," which Appellant takes to refer to the meanings of the first, second, third, fourth, fifth and sixth hosting service steps. Final Office Action, page 2.

**Appellant's Rebuttal**

Appellant respectfully submits that the claims clearly and distinctly recite six respectively different hosting service steps. Appellant also submits that the six respectively different hosting service steps recited in the claims are supported and clarified by the specification.

First, with regard to whether the hosting service steps are the same or different, claim 21 explicitly recites that the three hosting service steps are performed by respective differently named processes. Claim 21 ("the first shopping process performs …a first hosting service …the second resource planning process performs …a second hosting service …the second integration process performs …a third hosting service …"). This, by itself, makes it clear on its face that claim 21 recites first, second and third hosting service that are distinguished from one another. Further significance of the respective named processes will be addressed herein

below, both with regard to the claim and the specification, but next consider the fourth hosting service step.

Claim 21 recites that the fourth hosting service step includes "coupling communications between the second resource planning process," which performs the second hosting service, as the claim explicitly states, "and a second shopping process," which is a process not recited in the claim for any hosting services other than the fourth hosting service step. For at least this reason, it is clear on the face of claim 21 that the fourth hosting service is different than the others.

Regarding the fifth hosting service step, claim 21 recites that this includes "coupling communications between the first shopping process," which performs the first hosting service, as the claim explicitly states, "and a third resource planning process," which is a process not recited in the claim for hosting services other than the fifth hosting service step. For at least this reason, it is clear on the face of claim 21 that the fifth hosting service is different than the others.

Regarding the sixth hosting service, claim 21 recites that this includes "coupling communications between a certain process," which is a process not recited in the claim for hosting services other than the sixth, "and a third shopping process," which is a process not recited in the claim for hosting services other than the sixth. For at least this reason, it is clear on the face of claim 21 that the sixth hosting service is different than the others.

Further, beyond the mere fact that respectively different *individually named* processes are recited in claim 21 as executing for the respective first, second, third, fourth, fifth and sixth hosting service steps, the specification and claim provide still further guidance about meaning and limitations of the first, second, third, fourth, fifth and sixth hosting service steps. In particular, note that the claim specifically recites *where* the respectively different processes execute for each of the respective hosting service steps, i.e., whether they execute on the "data center host" or on a "remote host computer." See the explanation and illustration presented in the Summary of the Invention section herein above, in which Appellant has related these claim limitations to the specification.

Appellant acknowledges that the claim does not recite any particular number of remote hosts, so that the processes executing on a remote host are not limited to an particular remote

host. Appellant's illustration presented in the Summary of the Invention herein above is merely an example of an arrangement per the claim. However, as pointed out herein above, the Final Office Action has not presented a particular explanation of what teaching in the art meets the existing claim limitations, however broad or narrow the claim limitations may be. Appellant is not obligated to limit claims beyond what is necessary to patentably distinguish the invention over the prior art. The real issue should be whether Appellant has clearly stated something that is different and nonobvious with respect to the prior art. Breadth of a claim is not to be equated with indefiniteness. MPEP 2173.04 (citing In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)).

Further, beyond the respectively different *individually named* processes recited in claim 21 as executing for the respective first, second, third, fourth, fifth and sixth hosting service steps, and beyond the claim specifically reciting *where* the respectively different processes execute for each of the respective hosting service steps, the specification and claim make clear the respective *functions* of the respective, *individually named* processes. That is, for example, the claimed first shopping process is not only on a data center host computer system and is not only accessible to shoppers by Internet communications, but it also "communicates with a first integration process and a first resource planning process via Internet communications to transact first sales."

For at least these reasons, Appellant submits that the claim clearly and distinctly recites six respectively different hosting service steps. Appellant also submits that the six respectively different hosting service steps recited in the claims are supported and clarified by the specification.

## REQUEST FOR ACTION

Appellant submits that claim 21 is patentably distinct for at least the reasons set out herein above and that claims 4-7 and 9 are allowable at least because they depend on allowable claim 21. Appellant requests allowance and prompt passage of the application to issuance.

Respectfully submitted,

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Attachments: Claims Appendix, Evidence Appendix, Related Proceedings Appendix

# APPENDIX "AA" CLAIMS

1-3. (canceled)

4. (previously presented) The method of claim 21, wherein said second resource planning process comprises a process of an Enterprise Resource Planning (ERP) application.

5. (previously presented) The method of claim 21, wherein said first shopping process comprises a process of a WebSphere™ Commerce Suite of applications.

6 . (previously presented) The method of claim 21 , including the step of:

executing an application for a banking transaction process on the data center host computer system.

7. (previously presented) The method of claim 4, wherein said second resource planning process comprises a process of an SAP™ ERP application .

9. (previously presented) The method of claim 21, wherein said second integration process comprises a process of an MQ Series ™ of applications.

# APPENDIX "AA" CLAIMS

14 - 19. (canceled)

21. (currently amended) A method for offering hosting services, comprising the steps of:

a) hosting a plurality of applications on a host computer system at a data center, wherein hosting the applications includes:

executing an first shopping application for a first shopping process on the data center host computer system, the first shopping process being accessible to shoppers by Internet communications wherein the first shopping process performs the step of:

a first hosting service step, the first hosting service step including:

communicating with a first integration process and a first resource planning process via Internet communications to transact first sales, wherein the first resource planning process is a process of a first resource planning application on a host computer system located remotely from the data center and the first integration process is a process of a first integration application on a host computer system located remotely from the data center;

executing an application for a second resource planning process on the data center host computer system, wherein the second resource planning process performs the step of:

a second hosting service step, the second hosting service step including:

## APPENDIX "AA" CLAIMS

communicating with a production process via Internet or dedicated link communications, wherein the production process is a process of a production application on a host computer located remotely from the data center;

and

executing an application for a second integration process on the data center host computer system, wherein the second integration process performs the steps of:

a third hosting service step, the third hosting service step including:

coupling communications between the first shopping process and the second resource planning process to transact second sales;

a fourth hosting service step, the fourth hosting service step including:

coupling communications between the second resource planning process and a second shopping process, wherein the second shopping process is a process of a second shopping application accessible to shoppers by Internet communications on a host computer located remotely from the data center, the communications between the second resource planning process and the second shopping process being Internet communications to transact third sales;

a fifth hosting service step, the fifth hosting service step including:

coupling communications between the first shopping process and a third resource planning process to transact fourth sales, wherein the third

## APPENDIX "AA" CLAIMS

resource planning process is a process of a third resource planning application on a host computer located remotely from the data center;

and

a sixth hosting service step, the sixth hosting service step including:

coupling communications between a certain process and a third shopping process, wherein the third shopping process is a process of a third shopping application accessible to shoppers by Internet communications on a host computer located remotely from the data center and the certain process is a process of a certain application on a host computer located remotely from the data center;

and

b) performing a hosting service by the host computer system responsive to one of the customers selecting from among the first, second, third, fourth, fifth and sixth hosting service steps, and wherein sales are transacted with shoppers for the customers responsive to ones of the selected hosting service steps being performed on the host computer system.

22. (canceled)

# APPENDIX "BB" EVIDENCE

NONE.

# APPENDIX "CC" RELATED PROCEEDINGS

NONE.